

REMARKS

The first paragraph of the specification has been amended herein to recognize the issuance of the parent application. Claims 1, 2, 5 and 11 have been amended herein to make minor grammatical and formatting corrections.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-7, 9, 11, and 12) drawn to nucleic acids encoding SEQ ID NO:1.

Group II (claim 8) drawn to a transgenic organism comprising nucleic acids encoding SEQ ID NO:1.

Group III (claim 10) drawn to an antibody against SEQ ID NO:1.

Group IV (claims 13-15) drawn to a method of detecting nucleic acids encoding SEQ ID NO:1 via hybridization.

Group V (claim 25) drawn to a method of screening for compounds that bind to SEQ ID NO:1.

Group VI (claim 26) drawn to a method of screening for compounds that modulate the activity of SEQ ID NO:1.

Group VII (claim 27) drawn to a method of screening for compounds that change the expression of a nucleic acid that encodes SEQ ID NO:1.

Group VIII (claim 28) drawn to a method of assaying toxicity of a compound via a nucleic acid that encodes SEQ ID NO:1.

Group IX (claim 29) drawn to a method of diagnosing a disease via an antibody against SEQ ID NO:1.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-7, 9, 11, and 12. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants note that although Group I is described as being drawn to polynucleotides encoding SEQ ID NO:1, claims 1 and 2 of Group I are in fact drawn to polypeptides of SEQ ID NO:1 itself. Since SEQ ID NO:1 is encoded by the polynucleotides of Group I, as a search of the prior art to determine the novelty of the polypeptides would substantially overlap with the

searches of claims directed to the polynucleotides; thus Applicants agree that the grouping of the polynucleotide and polypeptide claims together in Group I is appropriate.

Applicants also submit that the inventions encompassed by Group IV (claims 13-15), Group VII (claim 27) and Group VIII (claim 28) are drawn to methods of use of the polynucleotides of Group I, and should be examined together. These method claims recite a product (i.e., a polynucleotide), which is of the same scope as the claimed polynucleotides being searched by the Examiner. Therefore, it would not be an undue burden on the Examiner to examine these method claims since the searches for the claimed polynucleotides and these method claims would substantially overlap. For the same reason, the claims of Group V (claim 25) and Group VI (claim 26), drawn to methods of use of the polypeptides of Group I, should also be examined together.

Applicants further suggest that Group III (claim 10), drawn to antibodies to the polypeptides, and Group IX (claim 29), drawn to a method of use of the antibodies, could be examined at the same time without undue burden on the Examiner, as a search of the prior art to determine the novelty of the antibodies would substantially overlap with the searches of claims directed to the polypeptides. Group II (claim 8), drawn to a transgenic organism comprising a polynucleotide of Group II, could also be examined at the same time as the polynucleotides of Group II also without undue burden on the Examiner as a search of the prior art to determine the novelty of the transgenic organism would substantially overlap with the search of claims directed to the polynucleotides. Applicants note that claims to polynucleotides and polypeptides, although of somewhat different scope, have already been examined and allowed in the parent application and first divisional application, respectively. Applicants respectfully submit that there is minimal additional burden on the Examiner to examine the claims of Groups II, III, and IX in addition to the claims elected in the present application, particularly in view of the searches and examination which were already conducted with respect to the previously issued claims and the additional burden on Applicants to file, prosecute and maintain yet another application in this family, and respectfully request that the Examiner consider doing so.

Additionally, the method claims of Group IV (claims 13-15), Group V (claim 25), Group VI (claim 26), Group VII (claim 27) and Group VIII (claim 28) are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In*

re Brouwer and 35 U.S.C. § 103(b)” which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows.

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the entirety of Applicants’ claims.

CONCLUSION

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,
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